REMARKS

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 21-41 are pending in this application.

Rejections under 35 U.S.C. § 102

Claims 21-31 and 33-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by O'Neil ('440).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 21, as amended, defines obtaining the personal information of the owner by an information source, wherein the information source may be any user of the Internet.

O'Neil does not disclose at least these limitations. Instead, O'Neil discloses a closed system, where participation is limited only to members of the trusted communities, see Abstract. Also, see the text beginning column 2, lines 10 regarding the discussion of the formation of trusted communities. See also column 7, line 53-column 8, line 14 describing the process of joining the trusted community. Consequently, only members of the community may participate in the transactions. Thus, O'Neil does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 21 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 34, as amended, comprises a receive module that receives a plurality of personal information of the plurality of the owners from at least one information source, wherein the at least one information source may be any user of the Internet.

O'Neil does not disclose at least these limitations. Instead, O'Neil discloses a closed system, where participation is limited only to members of the trusted communities, see Abstract. Also, see the text beginning column 2, lines 10 regarding the discussion of the formation of trusted communities. See also column 7, line 53-column 8, line 14 describing the process of joining the trusted community. Consequently, only members of the community may participate in the transactions. Thus, O'Neil does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 34 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 22-31, 33, and 35-41 depend directly from base claims 21 and 34, respectively, and thus inherit all limitations of their respective base claims. Each of claims 22-31, 33, and 35-41 sets forth features and limitations not recited by O'Neil. Thus, the Applicants respectfully assert that for the above reasons claims 22-31, 33, and 35-41 are patentable over the 35 U.S.C. § 102 rejection of record.

Rejections under 35 U.S.C. § 103

Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Neil ('440).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criteria.

The Office Action admits that O'Neil does not teach enabling the requestor to decline receipt of the personal information based upon a cost of the personal information. The Office

Action attempts to cure this deficiency by introducing common knowledge, which the Office Action alleges to teach having such an element. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Base claim 21 is defined as described above. O'Neil does not disclose these limitations, as discussed above. The modification of O'Neil with common knowledge is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claim 32 depends directly from base claim 21, and thus inherits all limitations of claim 21. Claim 32 sets forth features and limitations not recited by O'Neil as modified in the rejection. Thus, the Applicants respectfully assert that for the above reasons claim 32 is patentable over the 35 U.S.C. § 103(a) rejection of record.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10992073-3, from which the undersigned is authorized to draw.

Dated: August 20, 2003   Respectfully submitted,

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